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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,353	06/01/2001	Brian R. McCarthy	2991-US-B1	3630

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AVERY DENNISON CORPORATION  
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PASADENA, CA 91109-7090

EXAMINER
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CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1783

NOTIFICATION DATE	DELIVERY MODE
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12/29/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rachele.wittwer@averydennison.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 09/872,353	<b>Applicant(s)</b> MCCARTHY ET AL.	
	<b>Examiner</b> ALICIA CHEVALIER	<b>Art Unit</b> 1783	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 314-318,320,321,324-328,330,333,335-338,356,410 and 443-446 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 314-318,320,321,324-328,330,333,335-338,356,410 and 443-446 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **RESPONSE TO AMENDMENT**

### **Request for Continued Examination**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 14, 2010 has been entered.
2. Claims 314-318, 320, 321, 324-328, 330, 333, 335-338, 356, 410 and 443-446 are pending in the application, claims 1-313, 319, 322-323, 329, 331, 332, 334, 339-355, 357-409 and 411-442 have been cancelled.
3. Amendments to the claims, filed on October 14, 2010, have been entered in the above-identified application.

### **WITHDRAWN REJECTIONS**

4. The 35 U.S.C. §103 rejections made of record in the office action mailed April 15, 2010, pages 2-9, paragraphs #3-#6 has been withdrawn due to Applicant's amendment in the response filed October 14, 2010.

### **REJECTIONS**

5. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### **Claim Rejections - 35 USC § 112**

6. Claims 314-318, 320, 321, 324-328, 330, 333, 335-338, 356, 410 and 443-446 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “a continuous liner sheet **directly** and releasably secured to the paper cardstock sheet with ultraremovable adhesive” which is unclear and renders the claims vague and indefinite. Since the paper cardstock sheet, the continuous liner sheet and/or the ultraremovable adhesive could comprise more than one layer, it is unclear what is meant by "directly" secured to, e.g. the ordering and number of layers is unclear.

Claim 443 recites “a continuous liner sheet **directly** and releasably secured to the cardstock sheet with ultraremovable adhesive” is unclear and renders the claims vague and indefinite. Since the cardstock sheet, the continuous liner sheet and/or the ultraremovable adhesive could comprise more than one layer, it is unclear what is meant by "directly" secured to, e.g. the ordering and number of layers is unclear.

### **Claim Rejections - 35 USC § 103**

7. Claims 314, 315, 321, 324, 330, 333, 335-337, 410, 443, 444, 448, 453, 454, 459-463 and 466 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capozzola (U.S. Patent No. 4,863,195) in view of McKillip (U.S. Patent No. 5,462,488) and Popat et al. (U.S. Patent No. 5,407,718).

Regarding Applicant's claims 314, 443 and 444, Capozzola discloses a sheet (identification tag apparatus, col. 2, lines 56-57 and ref. #10) with a printable tag (col. 2, lines 6-

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7) comprising a cardstock sheet comprising paper; a continuous liner (over lay, col. 2, line 65 and ref. #101) sheet directly and releasably secured to the cardstock sheet with a layer of ultraremovable adhesive (col. 2, line 64 and ref. #5); continuous through-cut lines (serration, col. 2, line 68 and ref. #107) through the cardstock sheet but not through the continuous liner sheet (figure 2); and the continuous through cut lines defining at least in part perimeter edges of a printable tag in the cardstock sheet (figures 1 and 2). The printable tag has a surface that is coupled to the ultraremovable adhesive (col. 2, lines 62-64), and the printable tag is configured to be removed from the continuous liner sheet exposing the ultraremovable adhesive (figure 2) on the continuous liner sheet and the non-tacky printable tag's surface (col. 3, lines 25-33).

Capozzola fails to disclose that there is more than one business card, e.g. tag/label.

McKillip and Popat both disclose a business form/sheet with a plurality of cards/labels contain there on (McKillip, figures 5 and 11 and Popat figure 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate more than one tag/label/business card on the sheet of Capozzola as taught by McKillip and Popat in order to provide more tags per sheet to the consumer. One of ordinary skill in the art would have been motivated to provide more tags per sheet to the consumer because it would be more cost efficient for the consumer.

The preamble/limitation "business card" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that "business card" as the cut out portion or

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separable portion of the sheet construction (specification page 1, paragraph 2 and pages 4-5, paragraph 10). Capozzola's tag, McKillip's cards and Popat's labels are deemed to meet this limitation because they all also the cut out portions of the paper to be printed on.

Regarding Applicant's claims 315 and 448, Capozzola fails to disclose that the sheet has dimensions 8.5 by 11 inches, 8.5 by 14 inches or A4. However, Popat discloses that the label sheet may be a standard 8.5 by 11 inch sheet or other dimensions such as sheets with smaller dimensions, legal size or various other sizes which allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (col. 5, lines 1-11). Therefore, it would have been an obvious matter of design choice to change the size of sheet construction, since a modification would have involved a mere change in size. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). One of ordinary skill in the art would have been motivated to change the size of Capozzola's sheet in order to allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (Popat col. 5, lines 1-11).

Regarding Applicant's claims 321, 324, 333, 335, 453, 454, 460 and 461, Popat further discloses where in the printable tag/label is a first printable business card; the continuous through-cut lines define at least in part perimeter edges of a second printable tags/labels in the cardstock sheet; and the first printable tags/labels and the second printable tags/labels abut one another and are separated only by one of the through-cut lines and wherein the continuous through-cut lines include a grid of vertical and horizontal through-cut lines (figures 1 and 2). Popat further discloses that one of the continuous through-cut lines extends an entire width or length of the cardstock sheet and the continuous through-cut lines include horizontal and vertical

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through-cut lines, and a topmost one of the horizontal through-cut lines extends an entire width of the cardstock sheet (figures 1 and 2).

Regarding Applicant's claims 330 and 459, the limitation "to be printed using a non-impact printer" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Furthermore, the sheet of the combination of Capozzola, McKillip and Popat is deemed to configured to be printed using a non-impact printer, since Capozzola discloses the same claimed layers and McKillip and Popat discloses the same arrangement of the tags/labels/cards.

Regarding Applicant's claims 336, 410, 462 and 466, Capozzola discloses that the ultraremovable adhesive covers the entirety of the surface of the printable business card (col. 3, lines 25-26 and figure 2). The paper cardstock sheet has a back side and the continuous liner sheet covers all of the back side of the paper cardstock sheet (figures 1 and 2).

Regarding Applicant's claims 337 and 463, Capozzola discloses that the continuous liner sheet includes a base paper sheet (col. 4, line 5).

8. Claims 316, 325, 356, 449, 455 and 465 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capozzola (U.S. Patent No. 4,863,195) in view of McKillip (U.S. Patent No. 5,462,488) and Popat et al. (U.S. Patent No. 5,407,718) as applied above, and further in view of Mallya et al. (U.S. Patent No. 5,656,705).

Capozzola, McKillip and Popat are relied upon as described above.

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Capozzola, McKillip and Popat fail to disclose that the ultraremovable adhesive is a suspension-polymer ultraremovable adhesive.

Mallya disclose an ultraremovable adhesive made from a water based acrylic suspension-polymer (abstract) that has good storage stability and improvement in adhesive properties (col. 2, lines 33-35). The microspheres in the suspense (col. 2, lines 10-16) are deemed to provide only partial contact with the cardstock sheet and the partial contact prevents the ultraremovable adhesive from becoming permanent over time.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the suspension-polymer ultraremovable adhesive of Mallya as the ultraremovable adhesive in Capozzola in order to improve stability and the adhesive properties.

9. Claims 317, 318, 320 and 450-452 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capozzola (U.S. Patent No. 4,863,195) in view of McKillip (U.S. Patent No. 5,462,488) and Popat et al. (U.S. Patent No. 5,407,718) as applied above, and further in view of Yoshizawa et al. (U.S. Patent No. 5,670,226).

Capozzola, McKillip and Popat are relied upon as described above.

Capozzola, McKillip and Popat fail to disclose a primer coat between the ultraremovable adhesive and the continuous liner sheet, wherein the primer coat is a polyvinyl alcohol-based primer with silicate.

Yoshizawa discloses a primer coat comprising a polyvinyl alcohol-based primer with silicate (col. 9, lines 30-38). The primer layer helps anchor the adhesive to another layer when adhesion is low (col. 9, lines 25-30).



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It would have been obvious to one of ordinary skill in the art at the time of the invention to add the primer layer disclosed by Yoshizawa between the ultraremovable adhesive and the continuous liner sheet of Capizzole in order to ensure that the adhesive is anchored to the continuous liner sheet.

10. Claims 326, 327, 456 and 457 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capozzola (U.S. Patent No. 4,863,195) in view of McKillip (U.S. Patent No. 5,462,488) and Popat et al. (U.S. Patent No. 5,407,718) as applied above, and further in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

Capozzola, McKillip and Popat are relied upon as described above.

Capozzola, McKillip and Popat fail to disclose that an edge of the sheet is thinner than a body of the sheet or that the sheet is calendared.

Examiner's comment: The limitation "the printable business card sheet is calendared" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendared end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the printable business card sheet is calendared," since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (col. 6, lines 9-16). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (col. 1, lines 38-51).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet of Capozzola as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing. One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at col. 1, lines 38-51. It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

11. Claims 328 and 458 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capozzola (U.S. Patent No. 4,863,195) in view of McKillip (U.S. Patent No. 5,462,488) and Popat et al. (U.S. Patent No. 5,407,718) as applied above, and further in view of Hollis et al. (U.S. Patent No. 5,622,758).

Capozzola, McKillip and Popat are relied upon as described above.

Capozzola, McKillip and Popat fail to disclose that the liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet or that the narrow exposed strip is approximately ½ inch wide.

Hollis discloses a label sheet comprising a backing sheet and one or more labels affixed to the backing with adhesive (col. 5, line 62 through col. 6, line 20). The backing sheet has a leading edge and a trailing edge that extends out to form a narrow exposed strip extending the entire width of the liner sheet (col. 5, line 67 through col. 6, line 1 and figures 3 and 4). The label sheet is easily loaded into machinery (col. 4, lines 49-51).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have Capozzola's liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet as taught by Hollis in order to make the sheet material easy to load into machinery. The exact size of the narrow exposed strip of the liner sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as size of the narrow exposed strip, through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. MPEP 2144.05 II B.

12. Claims 338 and 464 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capozzola (U.S. Patent No. 4,863,195) in view of McKillip (U.S. Patent No. 5,462,488) and Popat et al. (U.S. Patent No. 5,407,718) as applied above, and further in view of Carlson (U.S. Patent No. 5,842,722).

Capozzola, McKillip and Popat are relied upon as described above.

Capozzola, McKillip and Popat fail to the cardstock sheet is a top-coated cardstock sheet.

Carlson discloses a printable laminate useful in forming die-cut identification cards, labels, etc. (col. 1, lines 16-18). The printable laminate includes die cut cards, which are coated with an ink receptive coating (col. 19, line 50 through col. 20, line 3). The ink receptive coating provides good ink image retention and adhesive retention (col. 20, lines 1-3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Carlson's ink receptive coating to the cardstock sheet of Capozzola in order to enhance the adhesion of the ink to the label. One of ordinary skill in the art would have been motivated

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to employ Carlson's ink receptive coating because of the improved image retention and adhesive retention of the ink (col. 20, lines 1-3). It is desirable to enhance the adhesion of the ink to the label so that the ink would not rub off after being applied to the label.

13. Claim 445 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Capozzola (U.S. Patent No. 4,863,195) in view of McKillip (U.S. Patent No. 5,462,488) and Popat et al. (U.S. Patent No. 5,407,718) as applied above, and further in view of Warther (U.S. Patent No. 5,495,981).

Capozzola, McKillip and Popat are relied upon as described above.

Capozzola, McKillip and Popat fail to the cardstock sheet is a magnetic substrate.

Warther discloses a sheet of cards, tags, labels and other sheet elements used in mailers (col. 1, lines 6-9). The cards can be provided with a magnetic strip to hold encoded date or be used as a credit card (col. 5, line 60 through col. 6, line 1 and col. 10, lines 44-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add a magnetic strip/substrate as taught by Wather to the cardstock sheet of Capozzola in order to be able to have encoded data on the tag or use the tag like a credit card.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

14. Applicant's arguments in the response filed October 14, 2010 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

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### **Conclusion**

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Thursday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/  
Primary Examiner, Art Unit 1783  
12/21/2010